Supreme Court, U.S.
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No. 95-711

IN THE
Supreme Court of the United States
OCTOBER TERM, 1995

EDWARD L. GUSSIN,
Petitioner,

v.

NINTENDO OF AMERICA, INC.
Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

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REPLY BRIEF FOR PETITIONER

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December 11, 1995

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In this Seventh Amendment case, the United States Court of Appeals for the Federal Circuit held that the interpretation of a patent claim, as well as the resolution of conflicting testimony with respect to literal infringement and infringement under the doctrine of equivalents, may be deemed issues of "law" amenable to summary judgment. The petition for certiorari demonstrated that this case presents the same question as is raised in *Markman v. Westview Instruments, Inc.*, No. 95-26 (cert. granted Sept. 27, 1995). Indeed, this case extends the reasoning of the Federal Circuit in *Markman* beyond the context of claim interpretation to questions of infringement which this Court has held for more than a century are the province of the jury.

1. Respondent contends that the local rules for the United States District Court for the Central District of California provided "an alternative basis on which to affirm the grant of summary judgment." Opp. Cert. 3. Even if this were true, it would not affect the question presented, because alternative holdings are not dicta. *Woods v. Interstate Realty Co.*, 337 U.S. 535, 537 (1949).

More fundamentally, respondent's claim is not accurate. The District Court *itself* stated that "the Court will *not* rely solely on [the supposed procedural defect] to support its Order and will

evaluate Defendant's motion on its merits." Pet. App. 17a (emphasis added). The District Court could hardly have ruled otherwise, since it had denied Gussin leave to file an amended Statement of Genuine Issues of Material Fact on the ground that — in the Court's words — "I think it would be a futile act." C.A. App. 1468.[1]

Thus, in the end respondent is forced to acknowledged that "the district court carefully proceeded to evaluate petitioner's arguments in opposition to the motion for summary judgment." Opp. Cert. 3. Indeed, the bulk of the brief in opposition is devoted to a defense of the District Court's weighing of the evidence at the summary judgment stage. Respondent concedes that "the district court undertook its own analysis of the record." *Id.* at 5.

Nor can respondent deny that the Court of Appeals, although it noted the issue of the local rules, proceeded to decide the case on the merits. The Court of Appeals applied *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (in banc), to reject Gussin's arguments regarding claim interpretation. The Court of Appeals explained that *Markman* "held that claim construction is a question of law amenable to summary judgment. *The alleged conflicting opinions of both parties' experts do not create genuine issues of fact precluding summary judgment as to the meaning of the claims at issue.* Therefore, we reject Gussin's argument that summary judgment was inappropriate." Pet. App. 6a (emphasis added and citation to *Markman* omitted). The Court of Appeals stated that its interpretation of the patent claims under *Markman* "is sufficient

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[1] Respondent's reliance (Opp. Cert. 8 n.5) on *Nilsson, Robbins, Dalgarn, Berliner, Carson & Worst v. Louisiana Hydrolec*, 854 F.2d 1538 (9th Cir. 1988), proves why its argument has no force here. *Nilsson* involved a litigant that "repeatedly refused to conform to the Local Rules and Federal Rules of Civil Procedure." *Id.* at 1541. The violations included three entries of default, four orders for monetary sanctions for failure to comply with court orders and discovery requests, and numerous hearings on motions to compel. *Id.* at 1541-42. The party was given many opportunities to cure its misbehavior and exhibited only willful disobedience.

to cause us to affirm the trial court's grant of summary judgment that Nintendo's device does not literally infringe." *Id.* at 10a.

2. Respondent also argues that there were no genuine issues of disputed material fact precluding summary judgment under the conventional, non-*Markman* standard of review. But this suggestion is sheer speculation, for the Federal Circuit cut off the inquiry at the outset by relying on *Markman*. Pet. App. 5a-6a. The Court of Appeals did not simply adopt the District Court's analysis of the record. Instead, it undertook its *own* review in order to determine whether Nintendo's system infringed on Gussin's, "as properly construed." *Id.* at 6a. The court examined the patent specification, prosecution history, and extrinsic evidence — such as the declaration of Mr. Gussin (who had himself been qualified as an expert witness in previous patent litigation in which he was not a party). *Id.* at 6a-10a. *Nowhere* in the court's decision is there any indication that it would have reached the same result absent *Markman*.

Although respondent inaccurately labels Gussin's evidence as "conclusory," Opp. Cert. 9, it simply ignores the extensive evidence supporting Gussin, which is documented in the Petition for Certiorari at 3-10 & nn. 2-10. While we believe it is clear that there were extensive issues of disputed fact precluding summary judgment under the usual standard of Fed. R. Civ. P. 56, there is no reason for this Court to reach that question, because the Federal Circuit itself did not reach it. The Court of Appeals instead relied on *Markman* — and explicably extended it to fact-intensive questions of infringement. Whether the Court of Appeals' approach is consistent with the Seventh Amendment is squarely presented for this Court's review. If respondent wishes to pursue its summary judgment motion on different grounds, it can do so after this case is remanded to the Federal Circuit.

CONCLUSION

The petition for a writ of certiorari should be granted or, at minimum, held pending disposition of *Markman v. Westview Instruments, Inc.*, No. 95-26. If for any reason this Court did not reach the Seventh Amendment question in *Markman*, we submit that the instant case would be an excellent one in which to address that exceedingly important and recurring issue.

Respectfully submitted.

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